

ESTTA Tracking number: **ESTTA602554**

Filing date: **05/06/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Bonusbox GmbH		
Entity	Limited Liability Company	Citizenship	Germany
Address	Schöenhauser Allee 44a Berlin, 10435 GERMANY		

Attorney information	Paul G. Juettner Greer, Burns & Crain, Ltd. 300 South Wacker Drive Suite 2500 Chicago, IL 60606 UNITED STATES tmdocket@gbclaw.net, smelby@gbclaw.net, pjuettner@gbclaw.net, lcrain@gbclaw.net Phone:(312) 360-0080
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Registration Subject to Cancellation

Registration No	4083747	Registration date	01/10/2012
Registrant	Netmasons Incorporated 4367 South 100 West Anderson, IN 46013 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2008/02/07 First Use In Commerce: 2010/07/13 All goods and services in the class are cancelled, namely: Providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services
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Grounds for Cancellation

Abandonment	Trademark Act section 14
Other	False Declaration, Trademark Act Sections 1 and 14

Attachments	117292.petition.to.cancel.pdf(21330 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Paul G. Juettner/
Name	Paul G. Juettner
Date	05/06/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PETITION FOR CANCELLATION

Petitioner believes that it will be damaged by U.S. Trademark Registration No. 4083747 for the mark Bonusbox, and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. Petitioner, Bonusbox GmbH is a limited liability company existing under the laws of Germany and having a principal place of business at Schönhauser Allee 44a, 10435 Berlin GERMANY.

2. On information and belief, the Registrant is an Indiana corporation located at 4367 South 100 West, Anderson, Indiana 46013.

3. Petitioner is the owner of U.S. Trademark Application No. 79143344 for the mark ‘BONUSBOX & design’ for *Computer software for bonus and incentive programs for electronic commerce applications, online advertising and online sales, in particular via electronic interactive social networks, including Facebook; database and database management software for interactive electronic networks, including the Internet; downloadable electronic publications about bonus and incentive programs for electronic commerce applications, online advertising and online sales; all of the foregoing goods not for the operation or support of the operation of amusement games, electronic games and games of chance for use with computers or screens and parts of the aforesaid goods,* in International Class 9; “Advertising services and promotional

publicity, in particular in the field of bonus and incentive programs; professional business and organizational consultancy, in particular in the field of bonus and incentive programs; marketing, in particular in the field of bonus and incentive programs; arranging and distributing of advertising goods and/or incentive services of all kinds; business consultancy, in particular in the field of bonus and incentive programs; goods and service presentations, namely bonus programs, incentive programs and advertising programs, in particular via electronic interactive social networks, including Facebook; compilation, updating and storing of data in databases; online publications, in particular in the field of bonus and incentive programs; online provision of information, in particular in the field of bonus and incentive programs; database management,” in International Class 35; and “Technical design and support of bonus and incentive programs, in particular via electronic interactive social networks, including Facebook; data capture and data management, in particular in the field of bonus and incentive programs via electronic interactive social networks, including Facebook; design of databases; computer services in the field of online data exchange, in particular in the field of customer service, customer support, sale and arranging of bonus and incentive programs via electronic interactive social networks, including Facebook; providing technological online data; design and development of computer hardware and software; operation of a platform for bonus and incentive programs via electronic interactive social networks, including Facebook; technical advice relating to the operation of an online platform for bonus and incentive programs, in particular on the Internet; technical

advice relating to the operation of an electronic platform for bonus and incentive programs, in particular Facebook,” in International Class 42.

4. On March 12, 2014, the U.S. Patent and Trademark Office refused registration of Petitioner’s U.S. Trademark Application No. 79143344 for “BONUSBOX & design” under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) based on an asserted likelihood of confusion with U.S. Registration No. 4083747 for the mark Bonusbox.

5. On information and belief, Respondent is the owner of U.S. Registration No. 4083747 for the mark Bonusbox for “*Providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services*” in International Class 35.

6. On information and belief, Respondent is not currently rendering the services of “providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services” in commerce under the Bonusbox mark.

7. On information and belief, in the three consecutive years preceding the filing date of this cancellation action, Respondent did not render the services of “providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services” in commerce under the Bonusbox mark.

8. On information and belief, as of and prior to June 3, 2011, the filing date of the application that resulted in Registration No. 4083747, Respondent had not rendered

the services of “providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services” in commerce under the Bonusbox mark.

9. Petitioner is likely to be damaged by the continued registration of Respondent's mark.

COUNT I – FALSE DECLARATION

10. Petitioner realleges and incorporates herein by reference each and every allegation of paragraphs 1 through 9 of this Petition.

11. On or about June 3, 2011, in its application that resulted in Registration No. 4083747, Respondent declared that the Bonusbox mark “was first used at least as early as 02/07/2008, and first used in commerce at least as early as 07/13/2010, and is now in use in such commerce” in connection with “Providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services.”

12. On information and belief, Respondent's declaration was false in that as of June 3, 2011 Respondent had not actually rendered the recited services in commerce and therefore had not used the mark in commerce.

13. Registration No. 4083747 was void *ab initio* due to the false declaration, and therefore, Registration No. 4083747 must be cancelled under Sections 1, 3 and 14 of the Trademark Act, 15 USC §§1051, 1053 and 1064.

COUNT II – ABANDONMENT

14. Petitioner realleges and incorporates herein by reference each and every allegation of paragraphs 1 through 13 of this Petition.

15. On information and belief, Respondent has discontinued use of the Bonusbox mark with intent not to resume use in connection with “providing incentive award programs for customers through issuance and processing of loyalty points for on-line purchase of company's goods and services.”

16. Respondent has abandoned the Bonusbox mark, and therefore Registration No. 4083747 must be cancelled under Section 14 of the Trademark Act, 15 USC § 1064.

WHEREFORE, Petitioner prays that Respondent’s Registration No. 4083747 for the mark Bonusbox be cancelled in whole.

The required \$300 fee is being charged to Deposit Account No. 07-2069.

Respectfully submitted,

Bonusbox GmbH

By: /Paul G. Juettner/
Attorney for Petitioner

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Suite 2500
Chicago, Illinois 60606
(312) 360-0080
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing PETITION FOR CANCELLATION has been served on:

Netmasons Incorporated
4367 S 100 W
Anderson, IN 46013-3633

by first-class, on this 6th day of May, 2014.

/Paul G. Juettner/

Attorney for Petitioner
Bonusbox GmbH

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